# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/708,839 | 03/26/2004 | Blayn W. Beenau | 70655.0300 | 2838 |

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| 66170          7590          01/25/2007<br>AMERICAN EXPRESS TRAVEL RELATED SERVICES CO., INC.<br>c/o SNELL & WILMER, L.L.P.<br>ONE ARIZONA CENTER<br>400 E. VAN BUREN STREET<br>PHOENIX, AZ 85004-2202 | **EXAMINER**<br><br>WALSH, DANIEL I |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2876 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 01/25/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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PTOL-90A (Rev. 10/06)

| | | **Application No.** | | **Applicant(s)** | |
|---|---|---|---|---|---|
| **Office Action Summary** | | 10/708,839 | | BEENAU ET AL. | |
| | | **Examiner** | | **Art Unit** | |
| | | Daniel I. Walsh | | 2876 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>02 November 2006</u>.

2a)☒ This action is **FINAL.**       2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

## DETAILED ACTION

1.      Receipt is acknowledged of the Amendment received on 11-2-06.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under

35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35

U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2.      Claims 1-7 and 9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Black (US 6,925,565), in view of Moebs et al., as discussed in the previous Office Action.

        Re claim 1, Black teaches receiving a proffered biometric sample at a sample receiver,

receiving user information at said sample receiver; associating the biometric sample with the

user information to create a data packet (FIG. 5A+, 4A, and abstract). The user information

stored is interpreted as a data packet that associates user information, biometric information, and transponder information as the transponder has a unique customer number/serial number that is part of the record. Though Black is silent to receiving transponder information and associating it with the user information and biometric sample as part of the data packet, the Examiner notes that each transponder has an associated unique record/serial number. Such unique identifying means serve as a well know and conventional means to identify and provide security to the system. Accordingly, it would have been obvious to one of ordinary skill in the art to receive the unique identifier and associate it with the data packet as a means to identify and verify the authenticity of the device. Black teaches associating the biometric sample being associated with at least one of a charge account, a credit card account, a debit card account, a savings account, a private label account, and a loyalty point account, as discussed above.

Black is silent to the sample being associated with a preloaded value defined by a preloaded value data file associated with the transponder information and associating the proffered biometric sample with a reload value defined by a reload protocol data file associated with the transponder information wherein, wherein the preloaded value data file and the reload protocol data file define predetermined values for use in satisfying a user transaction request and wherein the associating of the biometric sample with the preloaded value and the reload value facilitates biometric authorization for use of a combination of the preloaded value and the reload value to complete a transaction.

As understood by the Examiner, the preloaded value defined by a preloaded data file is analogous to a spending limit/credit limit/balance associated with a card whereas the reload value is analogous to overdraft protection. Moebs et al. teaches overdraft protection (paragraph

[0008] and [0014] ), as is known in the art for security and overdraft protection. The Examiner

notes that credit limits/account balances are also known in the art for security and protection

users.

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to combine the teachings of Black with those of Moebs et al.

One would have been motivated to do this for security and overdraft protection.

Though silent to a preload value, preload value data file, reload value, and reload data

file, as the transaction is performed electronically, it would have been obvious to one of ordinary

skill in the art to have corresponding files, or an electronic representation of the specific data in

order to permit such electronic processes to occur and for record keeping and updating. A

preloaded value, for example, a credit limit, is understood and conventional in the art. A reload

value, as taken as a overdraft protection, is also well known in the art, where a bank/funder for

an account, provides additional funds up to a predetermined amount, to cover transactions that

exceed available funds. As Black teaches above that the accounts are associated with

biometrics, it would be obvious that the values are also associated therewith, to enable a

transaction to complete.

Re claim 2, Black teaches contacting an authorized sample receiver through at least one

of a computer Internet, software, hardware, third party biometric entity, kiosk, biometric

registration terminal, and communication device (FIG. 1A). It is clear that during reception of

the sample that the receiver is in contact with one of a computer, internet, software, hardware,

biometric entity, kiosk, biometric registration terminal, and a communication device in order for

the sample to be received and to facilitate the transaction.

Re claim 3, Black teaches the receiving of the sample includes at least one of processing storing, comparing, and verifying the sample as a record is created as discussed above. It would have been obvious to one of ordinary skill in the art to process/store/compare/verify the sample as such means are conventional in the art to authenticate a sample (that it is real), and put it into a format that can be recognized, and stored for accessing and verifying a user.

Re claim 4, it has been discussed above that the proffered biometric sample is associated with at least one of personal information, credit card information, debit card information, savings account information, and loyalty point information (FIG. 3).

Re claim 5, Black teaches (FIG. 1A) that the data can be stored on a host computer or on the transponder itself (col 4, lines 29+), where is interpreted as being contained in at least one of a transponder, transponder reader, sensor remote server, merchant server, and transponder-reader system. Though Black is silent to database, Black teaches that according to the desired security, information can be stored on the transponder itself or remotely. Therefore, it is well within the skill in the art to store the data packet information at one of the locations set forth in the claim, depending on the desired type of security, using a database, which is a well known and conventional means to store and organize data.

Re claim 6, the Examiner notes that it is obvious that more than one sample can be registered, as the system is envisioned to be used with multiple users, hence multiple samples. Additionally, Baer, as discussed above, teaches multiple samples.

Re claim 7, the Examiner notes that though Black is silent, it would have been obvious to one of ordinary skill in the art that different samples (from different people) would be associated with different information from those others who are registered in the system.

Re claims 9-11, the limitations have been discussed above, where the Examiner notes it would have been obvious for different users to have different samples and information (unique users).

Re claim 12, it would have been obvious to one of ordinary skill in the art to use a secondary security feature to authenticate a user/sample. Such procedures are well known and conventional in the art, such as signatures, PIN, verifying that a sample is a real sample (from a living person, and examples include temperature and blood flow sensors). Such modification is an obvious expedient for security of the system.

Re claim 13, Black teaches that a unique identifier/customer number is associated with the user (FIG. 10A+). This is broadly interpreted as a personal identification number, or a unique means to verify a user/device. Additionally, the Examiner notes PIN-biometric combinations are well known and conventional in the art for increased security in systems. Therefore, using a PIN in addition to a biometric is an obvious expedient to increase security. The Examiner also notes as discussed in previous actions, that such teachings are known (de Sylva teaches that prior art systems use biometric and PINs for access (paragraph [0013])).

Re claim 14, the Examiner notes that it has been taught above and in the previous Office Action that the sample is received at one of a local database, remote database, portable storage device, host system, etc. as recited in the claim.

Re claim 15, a fingerprint scan, for example has been discussed above (see Black for example).

Re claim 16, as discussed above, Baer teaches the sample is associated with a preset transaction amount.

Re claim 17, overdraft has been discussed above, where a preloaded value (credit limit/balance) is funded with a reload value (overdraft) to enable a transaction to complete that normally exceeds an amount available, for example.

Re claim 18, as discussed above, a maximum amount/transaction limitation is conventional to associate with an account, for security and to prevent a user from overspending too much.

Re claim 19 and 20, Black teaches remote or local storing of the sample. Though silent to a government agency or third party security vendor, it would have been obvious to one of ordinary skill in the art to store the samples at such locations for enhanced security.

Re claim 21, as a user requires authorization to receive a credit card, for example, the establishment to a preload value/loading a preload value, inherently requires user authorization as part of the process.

3.      Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black as discussed above, in view of de Sylva.

The teachings of Black have been discussed above.

Black is silent to primary and secondary association.

De Sylva teaches primarily and secondarily associating different information with a sample based on preferences (30).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of de Sylva.

One would have been motivated to do this in order to have convenience via customer preferences.

Re claim 16, de Sylva et al. teaches that a user can specify that transactions greater than a certain amount be charged to certain accounts while smaller purchases are charged to a different account (paragraph [0047]). Therefore it would have been obvious to have a preset amount for an account to control charges.

4.      Claims 8, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black, as discussed above, in view of Moebs et al. (US 2005/0065872).

Black is silent to primary and secondary association.

Moebs et al. teaches primarily and secondarily associating different information with a sample based on preferences (paragraph [0017]).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Black with those of Moebs et al.

One would have been motivated to do this in order to have overdraft protection.

Re claim 16, as Moebs teaches overdraft protection, the Examiner notes that as the biometric is associated with accounts, it would have been obvious that a preset transaction amount would be associated as well, such as a maximum value (for credit limits and initiating a line of credit).

Re claim 17, Moebs et al. teaches associating more than one account together for overdraft protection as discussed above with regard to overdraft protection to facilitate a transaction.

## *Response to Arguments*

5.      Applicant's arguments with respect to the claims have been considered but are moot in

view of the new ground(s) of rejection. The Examiner has new grounds of rejections (above) for

the newly amended claims.


## *Conclusion*

6.      The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure (See PTO-892).

        Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
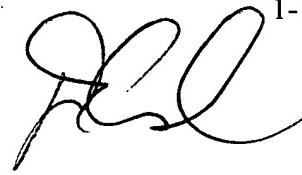
        A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel I Walsh
Examiner
Art Unit 2876
1-19-07

DANIEL WALSH
PRIMARY EXAMINER